

applicant's respectfully point out the original specification specifically stated, "Edible particulate matter 60 defines a free flowing edible particulate matter such as flavored candy powder, candy beads, or any other particulate type edible material" (see page 6, first paragraph, last sentence).

The following is a quotation of 35 USC § 112, first paragraph:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The applicants respectfully maintain that inasmuch as a "free flowing edible particulate matter such as flavored candy powder" was disclosed in the original specification, with respect to an "edible fluent non-gaseous material", the written description requirement of 35 USC § 112, first paragraph is satisfied. Thus even though an "edible fluent non-gaseous material" may read on a liquid, such reading on a liquid does no negate the satisfaction of 35 USC § 112, first paragraph's written description requirement. If on the other hand, the applicant's had claimed matter that was not supported in the original specification, such as for instance by "adding specific percentages or compounds after a broader original disclosure" or by "the omission of a step from a method", the applicant's would agree that new matter was added.

Thus by reading 35 USC § 112, first paragraph, the applicants urge that the test to determine new matter is not "Can the claims read on matter not disclosed in the specification?" as the examiner implies but rather "Are the claims supported by the original specification?". The applicant's argue that if the applicant's original specification can support the phrase in question, then the claimed subject matter cannot be construed to be new matter. The applicant's offer the following comparison as an example in support of their position. If for instance an applicant disclosed an automotive vehicle having red colored tires, ignoring any issues of novelty and obviousness, etc., the applicant's argue that the applicant should be entitled to claim "a vehicle having non-black colored tires". Conversely, by the reasoning established in the examiner's rejection, the applicant would not be able to make the noted claim as "a vehicle having non-black colored tires" would read on a vehicle having blue colored tires when only red colored tires were disclosed. Again, the applicant's disagree with the latter argument.

Accordingly, the applicant's suggest that a closer analysis of the phrase in question with respect to the specification will reveal that the original specification does in fact support the phrase in question. An analysis is as follows. It will be readily understood that the original specification taught a container that contained edible particulate matter (see for instance the original specification page 4, SUMMARY OF THE INVENTION, 1<sup>st</sup> sentence). It was further taught how the container resisted spills of the contained substance regardless of the orientation of the container. The specification made it clear that in order to achieve the described spill resistance per the described method, that the contained matter needed to exhibit the property of flow or in other words, the matter needed to be fluent. It will also be understood that particulate matter is neither a gas nor a gaseous substance. It follows then that even though an "edible fluent non-gaseous material" may read on a liquid, an "edible fluent (i.e. exhibiting a property of flow) non-gaseous (i.e. a particulate) material" is in fact supported by the original specification. In as much as it is established that the original specification supports the claimed subject matter, it is urged that a "new matter" rejection is not proper and it is requested that the examiner withdraw the rejection.

**OA Item #2: Claims Rejection under 35 USC § 103(a) - Obviousness:**

The examiner has rejected claims 1 – 14 and 21 – 25 under 35 USC § 103(a) based on the combination of Hunter (GB '356)/Martindale ('797) and Coleman ('884)/Hoeting et al ('870). The applicants respectfully traverse the examiner's rejection on the basis of both negative teachings and closely related commercial success.

Negative Teaching: As noted in the applicant's previous office action response, both Coleman and Hoeting recognized the problem of spillage of candy particulate and both attempt to address the problem in their respective inventions. It is also acknowledged that Coleman does provide a candy particulate container having a degree of spill resistivity. However, in as much as Coleman stores the lollipop product outside of the particulate containing compartment of the container, the container must be opened to access the particulate with the lollipop. By opening the Coleman container, the container is then of course rendered highly spillable much like any open-mouthed conventional container.

In an apparent effort to overcome this loss of spill resistivity, Hoeting redesigned his disclosed invention to place both the lollipop product and the particulate candy within the same "spill resistant"

closed container. And as with Coleman, so long as the Hoeting container remains closed, the Hoeting container is spill resistant. And as with Coleman, in order to use the Hoeting container, the Hoeting container must be opened, rendering Hoeting highly spillable. However, in spite of having access to Hunter and Martindale, not only have Coleman and Hoeting put forth edible particulate containers lacking the very funnel that could have solved the recognized problem, Hoeting introduced a new problem. The Hoeting product is analogous to an unassuming person holding a convention cup of coffee and wearing a wristwatch. When the person is asked what time it is, the person responds by turning his wrist to observe the face of his watch, only to spill his coffee from his cup. Likewise, because Hoeting placed the lollipop inside of the container with the candy particulate, it is a natural tendency for a user of the Hoeting product to spill the candy particulate when rotating the Hoeting container into a position to access the lollipop. In conclusion, Coleman and Hoeting, in spite of Hunter, Martindale, and all other prior art, have taught inventions that do not solve their own recognized problem of spill resistance of accessible particulate candy. The applicant's suggest that if their invention was obvious to one having ordinary skill in the art, then inventors such as Coleman and Hoeting who had access to art having containers with funnels, would have solved the problem as the applicants have done. Instead, in spite of the long felt need, other inventors such as Coleman and Hoeting have not invented the applicant's invention and Coleman and Hoeting have negatively taught spill resistance of particulate candy with convention non-funneled containers that are in fact highly spillable.

Commercial Success: The applicants respectfully suggest that the examination of the subject patent application is nearly identical to the examination of the patent application of which the subject application is a continuation. Specifically in examining the 5,246,046/RE36,131 application, bubble solution containers having some form of a funnel and/or spill resistance such as 2858,639, 3,579,898, 3,818,627, 4,840,597, and 5,088,950 and containers for liquid having funnels such as 676,924, 1,210,397, 5,022,559, and 5,105,975 were cited. However, in spite of such combined bubble solution container art and such funneled container art, the '046/RE36,131 examiner did not declare the invention to be obvious. Time has since vindicated this examiner's position. In 1993, approximately one year after the '046 application was filed, a product incorporating the technology disclosed in the '046 application was introduced to the market by the Little Kids corporation of Providence, Rhode

Island. Many other similar products made by many other companies also using the technology disclosed in '046 soon followed. In 1995, one of the current applicants, Michael R. Schramm, licensed the '046 patent to the Strombecker corporation of Chicago, Illinois. Subsequent to the Strombecker license agreement, Schramm also sublicensed Little Kids, inc., Imperial Toy, Inc., Toys R Us, inc., and Placo, Inc. In the decade since the first spill resistant bubble solution container incorporating '046 technology was introduced to the market, the product in it's many different embodiments, has gone on to generate multiple millions of dollars worth of retail sales. Various versions of the container continue to be available in every state of the union in stores such as Wal Mart, K Mart, and Toys R Us. The Applicants suggest that the spill resistant candy container is no more obvious

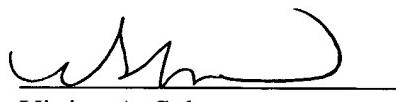
In conclusion, the Applicants suggest that the spill resistant candy container is no more obvious in light of powder containers having funnels and candy powder containers than the spill resistant bubble solution container was in light of bubble solution containers with a version of a funnel and spill resistant liquid containers. Given both the negative teaching and the related commercial success, it is urged that an "obvious" rejection is not proper and it is requested that the examiner withdraw the rejection.

**Conclusion:**

Applicants submit that the arguments presented herein have established the claims to be in condition for allowance. Action in accordance therewith is earnestly solicited.

If the Examiner has any questions or comments which may be resolved over the telephone, he is requested to call Michael R. Schramm at 801-625-9268 (wk) or at 435-734-2599 (hm).

DATE: November 20, 2003 Respectfully submitted,



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